

Docket No. F-6817

Ser. No. 09/762,530

to refer to "the (whole) entire top and bottom surfaces." Claims 33-35, Office Action page 5, 3rd paragraph. Although Applicant respectfully disagrees with this interpretation of the language, as discussed below, it also provides an indication that the initial reasonable interpretation of the word "coating", when not qualified by other language refers to the object referred to in its *entirety*. Alternatively, the Office Action is providing inconsistent interpretation of the language used in the current application. Thus, one skilled in the art can reasonably conclude that when the specification states that the "backing layer ... is *coated* on a top surface" that the coating is on the *entire* top surface.

Claims 11, 16-19, 22-29, 31-35 and 37 are rejected under 35 U.S.C. §103(a) as obvious over Marchal (GB Pat. No. 2,063,710) in view of the knowledge of one of ordinary skill in the art. Claim 30 is rejected under 35 U.S.C. §103(a) as obvious over Marchal in view of Su (U.S. Pat. No. 5,462,782). Claim 36 is rejected under 35 U.S.C. §103(a) as obvious over Marchal in view of Plumly (U.S. Pat. No. 5,363,579). More specifically, the Office Action asserts that Marchal discloses all the elements of the claimed invention except for the adhesive strengths and amount of adhesive per unit area, which are deemed to be obvious routine optimization parameters, an adhesive layer consisting of a weave of intersecting threads, which would have been obvious to one of ordinary skill in

Docket No. F-6817

Ser. No. 09/762,530

the art, the backing layer being made of propylene or polyethylene, which is disclosed in Su, and top and bottom surfaces having differential adhesive strengths by applying adhesives having different adhesive strengths, which is disclosed in Plumly. In other words, the Office Action characterizes the claimed invention as simply the combining of prior art elements according to known methods to yield predictable results.

MPEP §2143 states that when rejecting a claim based on the rationale that the recited structure is simply “combining prior art elements according to known methods to yield predictable results” there must be a “finding that the prior art included each element.” In addition, there must be a finding that “each element merely performs the same function as it does separately.” Furthermore, “if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” See MPEP §2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The applicants respectfully traverse the rejections because the prior art fails to include each element as recited in the claims.

In regard to claims 11, 27 and 32 the cited reference, Marchal, does not disclose the structural limitation reciting that the first and second pressure-sensitive

Docket No. F-6817

Ser. No. 09/762,530

adhesive coating patterns are the same. As Applicants stated in the remarks section of the previous Amendment filed on December 11, 2007:

“Marchal does not disclose first and second adhesive coatings with the same pattern.” If a first and a second adhesive coating on a self-adhesive sheet have the same pattern then they must have the same surface area. However, Marchal states specifically that “[o]ne side of the sheet 11 should always have a larger surface area of adhesive than the other side.” Thus, Marchal teaches away from first and second adhesive coatings with the same pattern.

Amendment of December 11, 2007 page 12, last paragraph. Moreover, this structural limitation of Marchal, which distinguishes the current claims from Marchal, has been recognized in the current as well as previous Office Actions. As evidence, it states in the current Office Action that Marchal “teaches *different* patterns result in different contact area for different adhesive contact strengths:” Office Action page 4, last paragraph (emphasis added). Claim 11 specifically recites that “a second pressure-sensitive adhesive coating coated in a second pattern that *is the same* as the first pattern on the bottom surface of said backing layer”. Claim 11 (emphasis added). Similar language is found in claims 27 and 32. Despite Applicants discussion of this issue the Office Action misinterprets this language as to simply convey that “both surfaces are coated with adhesive patterns”, not taking into consideration the language “is the same as the first pattern”. In other words, such an interpretation renders the words “ *that is the*

Docket No. F-6817

Ser. No. 09/762,530

same as the first pattern” meaningless surplusage. If the claim only recited “a second pressure-sensitive adhesive coating coated in a second pattern on the bottom surface of said backing layer”, i.e. without the language “is the same as the first pattern” the claim would provide the same scope as the interpretation asserted in the Office Action. Therefore, it is clear that the claims recite that the adhesive patterns on the top and bottom surfaces of the backing layer are the same. Thus, claims 11, 27 and 32 are non-obvious because Marchal does not disclose but teaches away from first and second adhesive coatings with the same pattern and modifying Marchal, as recited in the claims, would render it unsatisfactory for its intended purpose.

In order to further clarify this distinction with Marchal, Applicant added new claims 33-35 in the previous amendment. The claims specifically refer to the surface areas of the first and second *coatings* having an equivalent surface area. Moreover, Applicant explained that these claims were added in the previous amendment to distinguish the *coatings* of the current invention from Marchal. See Amendment of December 11, 2007 page 13, 1st paragraph. Despite the clear language of the claim and the discussion provided in the remarks, the Office Action interprets the claim language of the “surface area” to refer to “the whole (entire) top and bottom surfaces”. Office Action page 5, 3rd paragraph. In other

Docket No. F-6817

Ser. No. 09/762,530

words, the Office Action interprets the claim language of the "surface area" as referring to the top and bottom surfaces of the *backing layer*. However, the backing layer is not recited or referred to in the claims, it is the *coatings*. Therefore, the only reasonable interpretation of the claims is that the surface area of the *coatings* are equivalent. Moreover, Marchal specifically states that "one side of sheet 11 should always have a larger surface area of adhesive than the other side." Marchal page 2, lines 91-93. Thus, Marchal specifically teaches away from a self-adhesive sheet having equivalent surface areas on the top and bottom of the sheet as recited in claims 33-35. Therefore, claims 33-35 are non-obvious because Marchal does not include each element in the manner recited in the claims.

Applicants respectfully traverse the rejections of claims 17, 19, 24 for not providing an evidentiary basis for the rejections and because the prior art fails to include each element as recited in the claims.

In regard to claim 17, 19 and 24, the Office Action characterizes the application rate limitations recited as reflecting mere optimization of parameters. However, "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be

Docket No. F-6817

Ser. No. 09/762,530

characterized as routine experimentation.” MPEP §2144.05(II)(B) *citing In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). The Office Action does not substantiate that application rate of adhesive is a known result effective variable. Thus, the Office Action does not provide a sufficient evidentiary basis for the rejections.

Moreover, Marchal discloses that “an equally powerful adhesive is used for both sides” and that it is the “relationship between the adhesive *surfaces*” that allows the tape to adhere more firmly on one side. *See* Marchal page 2 lines 105-115 (emphasis added). Thus, even if, *arguendo*, application rate of adhesive is a known result effective variable, Marchal teaches away from having differing strengths of adhesive on the top and bottom of a backing layer. Therefore, claims 17, 19 and 24 are non-obvious in light of Marchal.

Applicants respectfully traverse the rejections of claims 31 and 32 for not providing a sufficient evidentiary basis for the rejections.

MPEP §2144.03 states that “[a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore,

Docket No. F-6817

Ser. No. 09/762,530

as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection." MPEP §2144.03 *citing Ahlert*, 424 F.2d at 1092, 165 USPQ 421. It is not "appropriate ... to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." *Id.* Thus, "specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." *Id.*

The Office Action asserts that it would have been obvious to one of ordinary skill in the art "to incorporate the intersecting threads in the top and/or bottom adhesive layers ... to obtain ... improved dimensional stability. Office Action, page 5, 1st paragraph. However, the use of a threaded mesh within an adhesive layer of a self-adhesive sheet is very specific knowledge and is not capable of instant and unquestionable demonstration as being well-known. Therefore, the Office Action does not provide a sufficient evidentiary basis for the rejections. Moreover, in claim 32 it specifically recites a rhomboidally threaded mesh. Even if, *arguendo*, it is known to incorporate intersecting threads in the top and/or bottom adhesive layers, it has certainly not been demonstrated that it is

Docket No. F-6817

Ser. No. 09/762,530

known in the art to have a rhomboidally threaded mesh. Thus, claims 31 and 32 are not rendered obvious in light of Marchal.

Claim 36 is cancelled herein thereby overcoming the rejection to the claim.

Applicants respectfully request a two month extension of time for responding to the Office Action. The fee of \$230 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Docket No. F-6817

Ser. No. 09/762,530

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg *by m. z. levoritz*
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

and,

By M. Zev Levoritz
M. Zev Levoritz
Reg. No. 50,151
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

enc: Form PTO-2038; Substitute Specification; and Marked Specification.